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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,585	07/11/2003	Donald Albert Paquet JR.	FA1048	3692

23906 7590 04/13/2005

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EXAMINER

CHEUNG, WILLIAM K

ART UNIT PAPER NUMBER

1713

DATE MAILED: 04/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/617,585

Applicant(s)

PAQUET ET AL.

Examiner

William K. Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 22-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 050304, 030804.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Applicant's affirmed election of Group I invention, claims 1-21, 26, without traverse is acknowledged. Therefore, in view of lack of traversal to restriction requirement set forth from Response to Restriction Requirement, the restriction set forth by the examiner is deemed proper and is therefore made Final.
2. Claims 1-26 are pending. Claims 22-25 are drawn to non-elected subject matter. Claims 1-21, 26 are examined with merit.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 1-21, 26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/109,948, claims 1-10 of copending Application No. 10/120,127, and claims 1-10 of copending Application No. 10/109,947. Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention of claims 1-21, 26 of instant application are related to claims 1-10 of copending Application No. 10/109,948, claims 1-10 of copending Application No. 10/120,127, and claims 1-10 of copending Application No. 10/109,947, as genus and its speices.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-21, 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,558,745, claim 1 of U.S. Patent No. 6,562,893, and claim 1 of U.S. Patent No. 6,551,712. Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention of claims 1-21, 26 of instant application are related to claims 1-10 of copending Application No. 10/109,948, claims 1-10 of copending Application No. 10/120,127, and claims 1-10 of copending Application No. 10/109,947, as genus and its speices.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 (line 1), the recitation of "non-functional" is considered indefinite because the monomers cited within the Markush group contains species having various functional groups such as phenyl, fluoro, bicyclic, polycyclic, and aromatic with 2-3 rings functional groups.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-16, 18-21, 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Barkae et al. (US 6,339,126 B1).

The invention of claims 1-16, 18-21 relates to a **coating composition** comprising **crosslinkable and crosslinking components**, wherein said crosslinkable component comprises: a copolymer having on an average **2 to 25 crosslinkable groups** selected from the group consisting of **hydroxyl, acetoacetoxy, carboxyl, primary amine, secondary amine, epoxy** and a combination thereof; a weight average molecular weight ranging from about **1000 to 4500**; a polydispersity ranging from about **1.05 to 2.5**; wherein said copolymer is polymerized from a monomer mixture comprising one or more **non-functional acrylate** monomers and one or more **functional methacrylate** monomers provided with said functional groups, and wherein said crosslinking component for said crosslinkable groups is selected from the group consisting of **polyisocyanate, polyamine, ketimine, melamine, epoxy, polyacid** and a combination thereof.

The invention of claim 26 relates to a **coating composition** comprising crosslinkable and crosslinking components, wherein said crosslinkable component comprises: a copolymer having on an average **2 to 25 crosslinkable groups** selected from the group consisting of **hydroxyl, acetoacetoxy, primary amine, secondary amine**, and a combination thereof; a weight average molecular weight ranging from about **1000 to 4500**; a polydispersity ranging from about **1.05 to 2.5**; wherein said copolymer is polymerized from a monomer mixture comprising one or more **non-functional acrylate** monomers and one or more **functional methacrylate** monomers

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*provided with said functional groups, and wherein said crosslinking component for said crosslinkable groups is selected from the group consisting of **polyisocyanate**, **ketimine**, **melamine**, and a combination thereof.*

Barkae et al. (abstract; col. 1, line 25-50; col. 21, line 15 to col. 22, line 28)

disclose a coatings composition and in example B, and Table 1, disclose a polycarboxylic acid functional polymer having Mw of 3550, and a MWD 1.25, and a crosslinking agent structure XII (col. 16, line 25-35) which comprises secondary amine structures (urethane). Barkae et al. (col. 16, line 5-35) clearly disclose that a polycarboxylic acid functional polyurethane may be used in the composition. Barkae et al. (col. 9, line 32-63) clearly shows a composition comprising both a functional acrylate monomers and functional methacrylate monomers. Barkae et al. (col. 10, line 26-45) disclose the composition can comprise hydroxyl groups containing monomers. Barkae et al. (col. 11, line 35 to col. 12, line 30) disclose the polycarboxylic acid functional polymer comprising glycidal (epoxy) functionalities (col. 12, line 25). Regarding the VOC limitation of claim 7, Barkae et al. (col. 1, line 50) indicate that the disclosed compositions have essentially zero VOC levels. Claims 1-16, 18-21, 26 are anticipated.

Regarding claims 9, 18, 21 which contains process related limitations, applicants must recognize that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in

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the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

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***Allowable Subject Matter***

10. Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and that the ODP rejection is overcome.

***Conclusion***

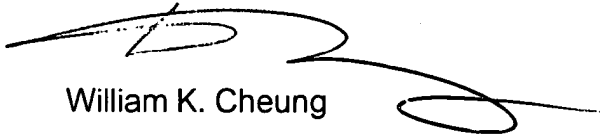
Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung

Primary Examiner

April 8, 2005

**WILLIAM K. CHEUNG  
PRIMARY EXAMINER**